

## **REMARKS**

### **I. Introduction**

Applicants appreciate the willingness of Examiner Campbell to conduct a telephone interview with the undersigned attorney on May 19, 2009. The following paragraphs contain a summary of the substance of that interview.

### **II. 35 U.S.C. § 103(a) Rejections**

#### **A. Overview of the Rejections**

Independent Claims 65 and 73 each recite operational instructions to receive first and second selections generated by a user pressing first and second buttons, respectively, of a keyboard, the first and second selections corresponding to first and second portions, respectively, of web information; and displaying the first and second portions of web information. These claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over the proposed combination of the “Using Netscape” reference by Ernst (hereinafter, “Ernst”) and U.S. Patent No. 5,867,729 to Swonk. In the Office Action, it was asserted that the “bookmark” functionality in the browser described in Ernst shows displaying first and second portions of web information when the user uses a mouse to click on displayed first and second bookmarks. The Office Action admits that Ernst does not teach making the bookmark selection by pressing first and second buttons on a keyboard and attempts to cure this deficiency by relying upon the general teaching in Swonk of using a key on a keyboard as a “shortcut” for some function. According to the Office Action, one skilled in the art would have been motivated to make that combination because “it would have allowed for increased usability for users with no pointing device available.”

Applicants respectfully request reconsideration and withdrawal of these rejections because one skilled in the art would not have been motivated to combine Ernst with Swonk and because the motivation to combine proffered by the Office Action is insufficient.

**B. One Skilled in the Art Would Not Have Combined Ernst with Swonk**

Applicants respectfully submit that the rejections against independent Claims 65 and 73 should be withdrawn because one skilled in the art would not have been motivated to combine Ernst with Swonk given the teaching in Ernst of using shortcut keys for some options but not for the selection of bookmarks and given the further teaching in Ernst that the number of bookmarks could be in the hundreds.

Ernst teaches the use of shortcut keys for some options but not for the selection of bookmarks. Specifically, pages 62-64 show and describe a menu bar with the word “Bookmarks.” A user can pull down the Bookmarks menu either by clicking on the word “Bookmarks” in the menu bar or by pressing Alt-B, as the underlined letter “B” indicates that a user can pull down that menu by simultaneously pressing the Alt key and the B key on the keyboard. Figure 4.1 on page 63 of Ernst shows the pulled-down Bookmarks menu. The first two items in the Bookmarks menu (“Add Bookmark” and “View Bookmarks”) can also be selected by using keyboard shortcuts, since letters in each of those two options are underlined. Specifically, a user can select the “Add Bookmark” option by pressing Alt-A (since the “A” is underlined) and, similarly, can select the “View Bookmarks” option by pressing Alt-B (since the “B” is underlined). The items listed under the “Add Bookmark” and “View Bookmarks” options are the names of the actual bookmarks. Significantly, none of the letters in the bookmark names are underlined, meaning that none of the bookmarks can be selected by using an “Alt” shortcut

key. Instead, as indicated in Figure 4.1, a user would move an arrow over and then click on a desired bookmark.

Bookmarks can also be accessed via a Bookmark List dialog box (see Figure 4.2 on page 63) that appears when the “View Bookmarks” option is selected under the pull down Bookmarks menu. As with the bookmarks listed under the pull down Bookmarks menu, none of the letters in the names of the bookmarks in the Bookmark List dialog box are underlined, so none of them can be selected by using an “Alt” shortcut key. Instead, as discussed on page 64, a user makes a selection by double-clicking over the name of the desired bookmark, by highlighting the desired bookmark name and then pressing the Go To button in the dialog box, or by typing in the bookmark name in the “find” field in the dialog box and pressing the Find button.

The absence of shortcut keys for the selection of bookmarks is consistent with the usage of shortcut keys in Ernst. Shortcut keys are used in Ernst when there are a relatively small number of selection choices. For example, the menu bar shown in Figure 4.1 has eight pull down menus, and each of these eight menus is associated with a shortcut key. As another example, there are two command options in the Bookmarks pull down menu, and each of these two options is associated with a shortcut key. In contrast, Ernst teaches that a user may have “hundreds of bookmarks” and that a user may have more bookmarks than can be displayed on a display screen (see page 63). Because of this, Ernst teaches the use of a scrollable and searchable list without the option to use a shortcut key.

The teaching in Ernst of using shortcut keys for some options but not for the selection of bookmarks begs the question, why weren’t shortcut keys used for the selection of bookmarks? This question is answered by the teaching in Ernst that the number of bookmarks could be in the hundreds. Given these teaching in Ernst, one skilled in the art would not have been motivated to

use shortcut keys for the selection of bookmarks, as proposed in the Office Action, because such usage would not be suitable for the number of bookmarks contemplated by Ernst. Accordingly, Applicants respectfully submit that the rejections of independent Claims 65 and 73 and their dependent claims should be withdrawn.

**C. The Motivation to Combined Proffered by the Office Action Is Insufficient**

In the Office Action, it was asserted that one skilled in the art would have been motivated to combine Ernst with the keyboard shortcut functionality in Swonk because the combination “would have allowed for increased usability for users with no pointing device available.” Applicants respectfully submit that this proffered motivation is insufficient. The proffered motivation of “increased usability for users with no pointing device available” assumes that the prior art contains an Internet browser that can be used without a pointing device. Applicants respectfully request that the Examiner provide a reference showing such an Internet browser. If such an Internet browser did not exist in the prior art, then there is no basis for the proffered motivation, and the rejections should be removed.

During the telephone interview, the Examiner mentioned that he was aware of a prior art Internet browser that could be used without a pointing device. Applicants requested that the Examiner provide a reference to that browser, but the Examiner did not produce the reference. Applicants respectfully repeat their request to provide a reference to that browser. Again, if such an Internet browser did not exist in the prior art, then there is no basis for the proffered motivation, and the rejections should be removed.

**III. Amendments to Dependent Claims 67, 68, 75, and 76 and New Claims 97 and 98**

In this Amendment, Applicants have amended dependent Claims 67, 68, 75, and 76 to clarify those claims. Specifically, those claims now recite operational instructions that

automatically configure the first and second buttons to correspond to the first and second portions of web information, respectively, according to a default configuration. In contrast, in the proposed combination, a user would manually configure keyboard shortcut keys to specific bookmarks. Accordingly, in the proposed combination, the configuration would be a *user-customized configuration – not a default configuration*, as recited in these dependent claims.

Regarding new dependent Claims 97 and 98, these dependent claims recite that the first and second buttons are each predefined to correspond to first and second portions of web information, respectively. This feature is not shown in the proposed combination since the shortcut keys are *user-customized – not predefined* to correspond to the first and second portions of web information, as recited in new dependent Claims 97 and 98.

In summary, even if there was motivation to combine Ernst and Swonk (which, as discussed above, there was not), dependent Claims 67, 68, 75, and 76 and new Claims 97 and 98 should be allowed because they recite features not shown in the proposed combination.

#### **IV. Conclusion**

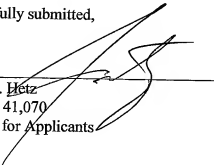
In view of the above remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully submitted. It should be noted that while only some elements of the independent and dependent claims were discussed above, other elements of the independent and dependent claims provide additional grounds of patentability. Applicants reserve the right to present these additional grounds at a later time, if necessary.

The Director is hereby authorized to charge payment of any additional fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

If the Examiner has any questions, he is invited to contact the undersigned attorney at  
(312) 321-4719.

Dated: May 20, 2009

Respectfully submitted,



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